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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,375	07/10/2001	Martin S. Niles		8831

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EXAMINER	
FULLER, ERIC B	
ART UNIT	PAPER NUMBER
1762	2

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding..

T-D 2

Offic Action Summary	Application No.	Applicant(s)	
	09/902,375	NILES, MARTIN S.	
	Examiner	Art Unit	
	Eric B Fuller	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *16-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15, drawn to a method for resisting electrical shorts, classified in class 427, subclass 421.

II. Claims 16-20, drawn to an apparatus for supporting an electrified wire, classified in class 174, subclass 137A.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a process that does not require a sprayed or liquified dielectric material can produce the product.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Alan J. Atkinson at mobile phone (281) 467-5566 on February 22, 2002 a provisional election was made without traverse to

prosecute the invention of Group I, claim1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US 5,997,894) in view of Detrick (US 5,599,374).

Blum teaches a process of coating electrical wires with a material so that they are protected from animal attacks (column 4, line 40). Applicant, on page 9 of the specification, defines "dielectric material" to be "any material... suitable for providing insulating capability between electrified wires and an electrical ground". Blum teaches the coating is non-conductive (column 4, line 34), and therefore reads on the applicant's definition of dielectric material. Blum further teaches that the coating is not only applied to the wire, but to any object subject to attack by animals (column 4, lines 46-50). One of ordinary skill would recognize that the since the wire is subject to attack by animals, the structure supporting the wire would be as well. Therefore it would be obvious to coat the structure supporting the wire with the coating of Blum as well as the wire. The

reference also teaches that the composition is mostly comprised of wax and/or oil being mixed with polymers and is applied by methods known in the art (column 3, lines 58-67; column 4, lines 1-10). The reference is silent to what these known methods are.

However, Detrick teaches that it is known to apply coatings of polymeric hydrocarbons, petroleum-based wax, or combinations of high viscosity polymeric paraffinic oil plus polyethylene by converting the material into a hot melt and spraying it on the substrate (column 1, lines 45-50). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply the coating of Blum by the spray method of Detrick, as it is a known method for applying the polymeric/oil coating. By doing so, applicant would have a reasonable expectation of success. To continue spraying until a desired thickness is achieved would also have been obvious. This reads on the limitations of claims 1, 2, 6, 8, 12, and 15.

As to claims 3, 5, 7, 10, 11, 13, and 14, to apply the coating before or after the installation of the wire to the support and with or without the wire being energized are all obvious variations of each other. To use either choice would have been obvious with the expectation of achieving similar results, as the effectiveness of the coating is not influenced by these parameters. Additionally, in cases where the wire is not energized, the electric potential between the support and the wire must be zero. Therefore the potential has been evaluated before the application of the coating.

As to claims 4 and 9, the reference is silent on how the thickness of the coating is determined. However, it is taught that the coating must have a desired hardness and be non-conductive. Therefore, to choose a thickness that has the desired hardness and

has zero conductivity (applicant's "desired dielectric insulating capability") would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kreinberg (US 4,973,370) and Clarke et al. (US 4,963,819) are all considered to be pertinent to the applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

EBF
March 25, 2002

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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